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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
BORLINGHAUS, JASON M

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/491,286	DAVIS ET AL.
	Examiner	Art Unit	
	Jason M. Borlinghaus	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 December 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *44-63* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *44-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 January 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 46 is objected to because of the following informalities: missing word.
Examiner suggests that applicant change the phrase "...the first manufacturer the same
as the second manufacturer..." to "...the first manufacturer *being* the same as the
second manufacturer..." to improve Claim clarity.

Claim 47 is objected to because of the following informalities: missing word.
Examiner suggests that applicant change the phrase "...the first computer network the
same as the second computer network..." to "...the first computer network *being* the
same as the second computer network..." to improve Claim clarity.

Claim 48 is objected to because of the following informalities: improper word.
Examiner suggests that applicant change the phrase "...the street values of the old
computer system with *or* without at least one reusable component" to "...the street
values of the old computer system with *and* without at least one reusable component" to
capture the applicant's true intentions. Examiner believes that applicant wants to obtain
two street values based upon two different computer configurations (one with and one
without the component) to better assist the user's financial analysis of his/her options.
Current wording suggests that the applicant wants only one street value based upon
one computer configuration (either with or without the component) which provides little
assistance to the user's financial analysis of his/her options.

Claim 52 is objected to because of the following informalities: improper
numbering within the Claim. Examiner suggests that the applicant change the phrase

"The method of Claim 45..." to "The method of Claim 44..." as the limitations stated in

Claim 52 limit the configuration request cited in Claim 44 and do not correspond to

reusable component selection cited in Claim 45. Applicant's attention is directed to the

factor that Examiner examined Claim 52 in light of its dependency on Claim 44 and not

Claim 45.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 44 - 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rathbone (Rathbone, A. *Upgrading & Fixing PCs For Dummies: 4th Edition*. Foster City,

CA, IDG Books Worldwide Inc, 1998. pp. 75 – 76, 163, 320 and 326) in view of Kraynak

(Kraynak, J. *The Complete Idiot's Guide to PCs: 6th Edition*. New York, NY, Alpha Books, 1998. pp. 297 and 304).

Regarding Claims 44, 45 and 47, Rathbone discloses a method of comparing hardware comprising:

- executing configuration utility software on the old computer system. ("Windows 95 and Windows 98 users can easily figure out what parts live inside their computer. Click the My Computer icon with your right mouse button and choose Properties from the pop-up menu...Click the Device Manager tab..." – see page 75, *How Do I Know What Parts I Have?*);

- storing the old configuration data as an old system configuration. ("The CMOS keeps track of all the parts currently installed inside your computer...Call up your computer's CMOS and copy its settings into the chart in Chapter 18 while the information's safe." – see page 326, *For the office PC guru...*);

- comparing the new hardware configuration data and the old hardware configuration data. ("Still, dissect that old 486 for its parts: Yank out the old video card, or buy a new old if the old card isn't PCI compatible. Grab the monitor and then attach it and the video card to your new computer." – see page 163, *Will Replacing My Old CPU With A Hot, New CPU Speed It Up ?* – comparing the old hardware configuration and new hardware configuration would be inherent in determining which components from the old computer system could be reused in the new computer system); and

- determining a compatible component list indicating which components of the old computer system may be reused in the new computer system. (see page 163, *Will Replacing My Old CPU With A Hot, New CPU Speed It Up ?* – determining compatibility of components would be inherent in reusing components from old computer system in new computer system); and

- selecting at least one component of the old computer system (video card and monitor) for reuse in the new system. (see page 163, *Will Replacing My Old CPU With A Hot, New CPU Speed It Up ?*)

Rathbone does not explicitly disclose a method comprising:

- accessing a first manufacturer's database, wherein accessing includes logging onto the storefront database from a first computer network;

- requesting information from an old computer system using a configuration request;

- receiving old configuration data for the old computer system from the first manufacturer's database;

- highlighting any components of the old computer system identified by the configuration utility software as differing from the old system configuration;

- altering the old system configuration to reflect any different components identified by the configuration utility software; and

- comprising first computer network being the same as the second computer network (Internet).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have modified Rathbone by incorporating the ability to request

configuration data from the manufacturer's database to provide an additional avenue

through which to secure configuration data of the old computer system. Rathbone

suggests multiple avenues through which to secure such information such as through

examination of old computer manuals and sales receipts, and executing configuration

utility software (see page 75, *How Do I Know What Parts I Have?*). However, whether

the old computer system accesses an external database or an internal database to

obtain the configuration data, the user would still have access to the same configuration

data.

Rathbone does not teach a method comprising:

- accessing a second manufacturer's new computer hardware catalog stored in

  a storefront database using a second computer network;

- transmitting a new hardware inquiry to the storefront database;

- receiving new hardware configuration data corresponding to a new computer

  system from the second manufacturer.

Kraynak discloses a method comprising:

- accessing a second manufacturer's new computer hardware catalog stored in

  a storefront database (website) using a second computer network (Internet).

  ("...shopping through a mail-order company, such as Gateway 2000, Micron

  Electronics, or Dell. All these companies have websites, where you can check

out their current products without having to deal with a salesperson..." – see

page 304, *Shopping on the Internet*);

- transmitting a new hardware inquiry (searching system descriptions) to the

  storefront database (via website). ("All these companies have websites, <u>where

  you can check out their current products</u> without having to deal with a

  salesperson..." – see page 304, Shopping on the Internet. " Read the system

  descriptions next to each computer..." – see page 297, *Computer Buyer's

  Checklist*); and

- receiving new hardware configuration data (receiving system descriptions)

  corresponding to a new computer system from the second manufacturer. (see

  page 304, Shopping on the Internet and see page 297, *Computer Buyer's

  Checklist*).

It would have been obvious to a person of ordinary skill in the art at the time of

the invention was made to have modified Rathbone by incorporating the ability to

retrieve configuration data for a new computer system, as was illustrated by Kraynak, to

ensure that components from the old computer system would be compatible with the

new computer system. Furthermore, it would have been obvious to a person of ordinary

skill in the art at the time of the invention to have automated the method of retrieving

information, comparing information and determining component compatibility because it

would have sped up the process, which was known, and the end result would have

been the same as compared to the manual method. *In re Venner, 262 F.2d 91, 95,

1209 USPQ 193, 194 (CCPA 1958).*

Regarding Claim 46, neither Rathbone nor Kraynak teach a method further

comprising the first manufacturer being the same as the second manufacturer.

It would have been obvious to a person of ordinary skill in the art at the time of

the invention was made that the first manufacturer of the old computer system and the

second manufacturer of the new computer system could have been the same. Kraynak

provides "a list of popular mail-order companies" which only include four manufacturers

– Micron, NEC, Dell and Gateway (see page 304, *Shopping on the Internet*).

Considering the limited number of popular manufacturers, as indicated above, and

brand loyalty among consumers, it would have been possible for consumers to

purchase their new computer system from the same manufacturer as their old computer

system.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Rathbone and Kraynak, as with Claim 44 above, and in further view of Kaplan (Kaplan,

K. *Integrating Old PCs Back Into Society. Los Angeles Times*. (December 20, 1995).

p.4).

Neither Rathbone nor Kraynak teach a method further comprising determining

the street values of the old computer system with and without at least one reusable

component.

Kaplan discloses a method further comprising determining the street values

(price quote) of the old computer system with and without at least one reusable

component (depending upon the configuration). ("...RTI will pay for the machines.

Depending on the configuration, condition and manufacturer of a computer, RTI will pay $100 to $200 for a used 286 PC....").

It would have been obvious to have incorporated into Rathbone and Kraynak, the determination of the street values of the old computer with and without reusable components, as was illustrated by Kaplan, to assist in financial analysis of component reuse by determining whether the reusable component has more value as a reusable component or as something to be sold with the old computer system.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Kraynak and Kaplan, as with Claim 48 above, and in further view of Siguel (Siguel, E.N. A *PC Buyer's Primer. Medical Laboratory Observer*, vol. 26, no. 10 (October 1994). pp. 70 – 73).

Rathbone, Kraynak nor Kaplan teach a method further comprising determining whether to reuse a component of the old computer system in the new computer system based on the street values.

Siguel discloses a method further comprising determining whether to reuse a component of the old computer system in the new computer system based on the street values (financial considerations). ("Upgrade if you can save and reuse many components you already have, such as a large hard drive...monitor, keyboard, case, power supply, and CD, tape, and floppy drives. You should probably buy a new computer if you need a new monitor or hard drive in addition to the motherboard...The saving due to reusing only your floppy drives, case, and power supply are usually

insufficient to justify upgrading the old system. Reusing an old, small hard drive is

probably not cost-effective...").

It would have been obvious to have incorporated into Rathbone, Kraynak and

Kaplan, the determination of the financial value of reusing a component from the old

computer system, as was illustrated by Siguel, to establish whether reusing a

component from the old computer system in the new computer system would be cost-

effective.

Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Rathbone, Kraynak and Kaplan, as with Claim 48 above, and in further view of Barzilai

(US Patent 6,012,045).

Rathbone discloses a method further comprising disposing of an old system

configuration minus at least one component to be reused in the new computer system.

("If you donate your old 486 and buy a Pentium, however, first remove the video card

and keep the monitor. Then plug these into your new replacement Pentium." – p. 320,

Upgrading Computers Older Computers Like the 486.).

Rathbone, Kraynak nor Kaplan teach a method further comprising transmitting a

hardware description to an online auction site comprising the old system configuration

minus at least one component to be reused in the new computer system.

Barzilai discloses a method further comprising transmitting a hardware

description to an online auction site. ("The computer system electronically establishes a

virtual showroom accessible by the customer's computers which displays consumer

goods and services and information regarding the commonly available selling price for

each product and service. For example, the system displays the manufacturer's suggested retail price or MSRP, a minimum opening bid price, information regarding the make, model and manufacturer or distributor of the offered product or service, and bid cycle data revealing the open, close and acceptance dates for the bids." – see abstract – the online auction site's ability to display information, such as a hardware description, would make it inherent that the seller could transmit that same information to the online auction site for display).

It would have been obvious to have incorporated into Rathbone, Kraynak and Kaplan, the ability to transmit a hardware description to an online auction system, as disclosed by Barzilai, in order to sell the old computer system without those components that the user has determined to salvage from the old system, as illustrated by Rathbone, to recover some financial benefit from the disposing of the old computer system.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone and Kraynak, as with Claim 44 above, and in further view of Sparks (Sparks, P. *Getting Personal: A Growing Number of Computer-Buyers Are Opting For Made-To-Order Machines. The Augusta Chronicle.* (February 16, 1999), p. B01).

Neither Rathbone nor Kraynak disclose a method further comprising obtaining price estimates for the new computer system with and without the component selected for reuse.

Sparks disclose a method further comprising obtaining price estimates (price quotes) for the new computer system with and without the component selected for reuse. ("The program asks what size and type of hard drive you want, how much

memory you think you'll need, what type of motherboard you want, if you would like a

video card, a Zip drive, sound card, CD-ROM drive or DVD player, and it also gives

options for selecting various computer programs. A price quote appears on the screen,

and a sales person reviews your picks with you before your purchase.")

It would have been obvious to have incorporated into Rathbone and Kraynak the

ability to obtain price estimates for the new computer system with and without the

component selected for reuses, as illustrated by Sparks, to assist in financial analysis of

component reuse by determining whether it would be cost-effective to reuse component

from old computer system or purchasing a new computer system with new component.

Claims 52 - 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Rathbone and Kraynak, as with Claim 44 above, and in further view of Anonymous

(Anonymous. *Are You Y2K Complaint. The API Account*. Baltimore: Spring 1999, vol.

26, issue 1, p. 3).

Regarding Claim 52, neither Rathbone nor Kraynak teach a method wherein the

configuration request further comprises a unique tag corresponding to the old computer

system.

Anonymous discloses a method wherein the configuration request further

comprises a unique tag (serial number) corresponding to the old computer system.

("You will need to know the model of your computer, your serial number, and the

manufacturer." – it is inherent that the serial number is a unique tag corresponding to

the computer system).

It would have been obvious to have incorporated into Rathbone and Kraynak the labeling of the configuration request with a unique tag corresponding to the old computer system, as illustrated by Anonymous, to properly and accurately link the configuration request to the user's specific old computer system.

Regarding Claim 53, Claim 53 recites similar limitations to Claims 44, 45 and 52, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 44, 45 and 52.

Regarding Claim 54, Claim 54 recites similar limitations to Claim 44 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 44.

Regarding Claim 55, Claim 55 recites similar limitations to Claims 46 and 47, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 46 and 47.

Regarding Claim 56, Claim 56 recites similar limitations to Claim 45 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 45.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rathbone, Kraynak and Anonymous, as with Claim 53 above, and in further view of Barzilai.

Claim 57 recites similar limitations to Claims 50 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 50.

Claims 58 – 60 and 62 – 63 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rathbone, Kraynak, Kaplan, Siguel and Sparks.

Regarding Claim 58, Claim 58 recites similar limitations to Claims 44, 45, 48, 49

and 51 in combination, except:

- computing transaction amounts with and without reuse of the reusable

  component; and

- selecting the lowest transaction amount.

However, it would have been obvious to have incorporated into Rathbone,

Kraynak, Kaplan, Siguel and Sparks the computation of transaction amounts with and

without the reuse of reusable components, and selecting the lowest transaction amount

to ensure that reusing components from the old computer system was cost-effective. It

is fundamental to the practice of reusing components that the reuse of components be

cost-effective and that the user of such a method would seek to minimize his/her

transaction costs. Furthermore, as Siguel stated "Reusing an old, small hard drive is

probably not cost-effective...", establishing that the assessment on whether to reuse a

component from an old computer system ultimately rests upon whether it would be

financially wise to reuse the possible component.

Regarding Claim 59 - 60, Rathbone discloses a method further comprising

reusing a component from the old computer system in the new computer system ("If you

donate your old 486 and buy a Pentium, however, first remove the video card and keep

the monitor. Then plug these into your new replacement Pentium." – p. 320, *Upgrading*

Computers Older Computers Like the 486 – establishing that the user would intend to reuse the old component in the new computer system).

Rathbone, Kraynak, Kaplan nor Siguel teach a method further comprising modifying the new configuration data to omit/indicate at least one reusable component selected based on the lowest transaction amount and ordering a new computer system corresponding to the new configuration data.

Sparks disclose a method further comprising modifying the new configuration data (new computer system specifications) to omit at least one component and ordering a new computer system corresponding to the new configuration data. ("The program asks what size and type of hard drive you want, how much memory you think you'll need, what type of motherboard you want, if you would like a video card, a Zip drive, sound card, CD-ROM drive or DVD player, and it also gives options for selecting various computer programs. A price quote appears on the screen, and a sales person reviews your picks with you before your purchase." – establishing that the user can modify and order a new computer system configuration, omitting components from the new computer system should they choose to do so.)

It would have been obvious to have incorporated into Rathbone, Kraynak, Kaplan and Siguel the ability to modify and order a new computer system configuration, as illustrated by Sparks, to accommodate the possible reuse of components from the old computer system, as illustrated by Rathbone, to reduce the cost of a new computer system.

Regarding Claims 62 – 63, Claims 62 – 63 recite similar limitations to Claim 44

and are therefore rejected using the same art and rationale as applied in the rejection of

Claim 44.

Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Rathbone, Kraynak, Kaplan, Siguel, Sparks and Barzilai.

Rathbone discloses a method further comprising disposing of an old system

configuration minus at least one component to be reused in the new computer system.

("If you donate your old 486 and buy a Pentium, however, first remove the video card

and keep the monitor. Then plug these into your new replacement Pentium." – p. 320,

Upgrading Computers Older Computers Like the 486.).

Rathbone, Kraynak, Kaplan, Siguel nor Sparks teach a method further

comprising modifying the old configuration data to omit at least one reusable component

selected based on the lowest transaction amount and transmitting the old configuration

data to an online auction system.

Barzilai discloses a method further comprising transmitting the old configuration

data (product information) to an online auction system. ("The computer system

electronically establishes a virtual showroom accessible by the customer's computers

which displays consumer goods and services and information regarding the commonly

available selling price for each product and service. For example, the system displays

the manufacturer's suggested retail price or MSRP, a minimum opening bid price,

information regarding the make, model and manufacturer or distributor of the offered

product or service, and bid cycle data revealing the open, close and acceptance dates

for the bids." – see abstract – the online auction site's ability to display information, such as product information, would make it inherent that the seller could transmit that same information to the online auction site for display).

It would have been obvious to have incorporated into Rathbone, Kraynak, Kaplan, Siguel and Sparks, the ability to modify and transmit the old computer system configuration to an online auction system, as disclosed by Barzilai, in order to sell the old computer system without those components that the user has determined to salvage from the old system, as illustrated by Rathbone, to recover some financial benefit from the disposing of the old computer system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to (*Compaq Alleges Parts Swindle. Information Week*, no. 528 (April 24, 1995). p. 32) and this reference is considered to be relevant to the claimed invention due to its reference to dismantling old computer systems and reusing components in new computer systems for sale. Additionally, the references cited to Hess (US Patent 6,058,417) and Carlton-Foss (US Patent 6,647,373) and these references are considered to be relevant to the claimed invention due to their reference to online auctions. In particular Carlton-Foss uses the example of listing computer specifications on its online auction site.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (703) 308-9552. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

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